

### REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and following remarks is respectfully requested.

Claims 8-10, 12 and 14 are pending in this application. By this amendment, the specification is amended; Claims 11 and 13 are canceled; and no claims are amended or added herewith. It is respectfully submitted that no new matter is added by this amendment.

In the outstanding Office Action, Claims 8-14 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,983,524 to Polegato in view Applicants' admitted prior art (AAPA).

The specification is amended to clarify features of the present invention. That is, thermoplastic polyurethane was inadvertently included in the PCT application when the Italian priority document was translated into English. Accordingly, thermoplastic polyurethane was incorrectly included in the specification and has been deleted from the specification by the present amendment. The Examiner's attention is directed to page 6, lines 1-6 of the specification which immediately follows the amended paragraph discussed above, in which it is recited that practical tests of the use of these thermoreactive adhesives ...." As such, the present specification is discussing thermoreactive adhesives and not thermoplastic adhesives.

With respect to the rejection based on AAPA and Polegato, it is respectfully submitted that the applied art does not teach or suggest a membrane being connected in spots with a lower protective layer, in which the membrane is associated with the protective layer by a thermoreactive adhesive, as recited in Claim 8 and similarly recited in Claims 12 and 14.

Instead, Polegato discloses that the membrane 15 and lower protective layer 16 are coupled to one another by spot gluing, using a commercially available adhesive that is resistant to hydrolysis. The Office Action acknowledges that Polegato does not disclose that

the spot gluing uses a thermoreactive adhesive. Applicants submit, for at least the reasons discussed above with respect to the error in the specification, that a first difference between the claimed invention and the applied art is that the gluing between the membrane and the lower protective layer is a spot gluing with a thermoreactive adhesive, while in the applied art a thermoplastic adhesive is used.

The difference between a thermoreactive adhesive and a thermoplastic adhesive is that the thermoreactive adhesive forms a three-dimensional structure that is thermally irreversible. In contrast, a thermoplastic adhesive (as used in the applied art), when it reaches a temperature that is higher than its melting point, goes back to the fluid condition, thus losing all its gluing capability. The need of using a different adhesive arises from the consideration that the applied art suffers a drawback. That is, during the molding step of the tread, the high temperature would lead the adhesive to lose its gluing capability as discussed above. As such, the membrane and the lower protective layer came unglued from one another but the membrane remained attached to the tread and thus, was subject to the stresses transferred to the tread from walking, which resulted in tears.

However, the use of a thermoreactive adhesive overcomes the above problem since the adhesive does not go back to its fluid condition even if subjected to high temperatures. Thus, the gluing capability is not affected. Accordingly, the membrane does not come unglued from the lower protective layer and the stresses due to walking are absorbed by the assembly constituted by the membrane and the protective layer. The higher thickness of the assembly composed by the membrane and the lower protective layer better absorbs the stresses and the membrane is less susceptible to tears.

Moreover, it is respectfully submitted that there is no basis in the teachings of the applied art to support their applied combination. Certainly, the outstanding Office Action fails to cite to any specific teachings within either reference to support the applied

combination. The Office Action asserts that it would be obvious for one skilled in the art to use a different type of adhesive, i.e. a thermoreactive adhesive, since such adhesive is already used in the medical field. Applicants respectfully submit that the medical field and the field of shoes are far from one another. Additionally, the use of the thermoreactive adhesive has been prompted by the perception of a technical problem that specifically relates to treads with membranes and protective layers and thus strictly relates to the field of shoes. Accordingly, it is respectfully submitted that the combination of the applied art is the result of hindsight reconstruction in view of the teachings of the present specification, and is improper.

Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 103(a) is respectfully requested.

Consequently, for the reasons discussed in detail above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below-listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Steven P. Weihrouch  
Attorney of Record  
Registration No. 32,829

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)

Kevin M. McKinley  
Registration No. 43,794